

REMARKS

STATUS OF THE CLAIMS

Claims 1, 4-8 and 11-22 are presently pending. No claim amendments have been made, and thus no new matter has been added. Applicants thank the Examiner for withdrawing the rejection of the claims in view of EP 620268 claims.

A. DOUBLE PATENTING

The Examiner has provisionally rejected claims 1, 4-8 and 11-22 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6, 8, 12-19, 21-23, 25 and 27-31 of copending Application No. 10/693,197. See pages 3-7 of the Office Action. Applicants respectfully request abeyance of the rejection until patentable subject matter has been found.

B. REJECTIONS UNDER 35 U.S.C. §103

1. U.S. Patent Application No. 2002/0119895

The Examiner has rejected claims 1, 4-5, 7-8, 11-12, and 14-20 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application No. 2002/0119895 to Cook et al. ("Cook") in view of U.S. Patent No. 4,755,311 to Burjes et al. ("Burjes").

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness. In particular, the Examiner has failed to establish that the combination of references teaches or suggests the claimed invention.

The Examiner has argued that Cook allegedly discloses a composition used as gear lubricant and in turbines wherein the composition comprises a polysulfide, a dithiocarbamate, and an amine salt of monothiophosphoric acid wherein the amine includes ethoxylated N-tallow trimethylene diamine. See page 8 of the Office Action.

However, the Examiner has failed to establish that Cook teaches or suggests the particular hydrocarbylamine compounds presently claimed, e.g., N-oleyl-trimethylene diamine, N-tallow-trimethylene diamine, N-coco-trimethylene diamine, and combinations thereof. As the Examiner has acknowledged, Cook specifically teaches "ethylene oxide condensation products of N-tallow trimethylenediamine." See page 13, para. [0139].

The reference thus teaches a modified N-tallow trimethylenediamine compound and not the claimed N-tallow trimethylenediamine. Conversely, the presently claimed load carrying capacity enhancing combination comprises a hydrocarbylamine compound selected from the group consisting of N-oleyl-trimethylene diamine, N-tallow-trimethylene diamine, N-coco-trimethylene diamine, and combinations thereof, and not the "ethylene oxide condensation products" thereof as disclosed in Cook. Therefore, Cook does not teach or suggest the claimed hydrocarbyl compound (b)(i).

Moreover, Cook does not teach or suggest the claimed load carrying capacity enhancing combination. Cook teaches that its amine compounds (such as the "ethylene oxide condensation products of N-tallow trimethylenediamine") are used in preparing a phosphoric acid ester salt. See page 12, paras. [0128] and [0139]. As discussed above, the reference does not teach or suggest the presently claimed hydrocarbylamine compounds. Therefore, because Cook fails to teach or suggest the presently claimed hydrocarbylamine compounds, its resultant salt would also fail to teach or suggest the presently claimed load carrying capacity enhancing combination.

Burjes does not overcome the deficiencies of Cook. In particular, the Examiner relied on Burjes, a reference disclosed in Cook, for teaching specific types of monothiophosphoric acids. However, Burjes does not teach or suggest the claimed

hydrocarbyl compound (b)(i) or the claimed load carrying capacity enhancing combination (b). For at least these reasons, the Examiner has failed to establish a *prima facie* case of obviousness.

Therefore, the combination of Cook and Burjes fails to teach or suggest all of the claimed elements. For at least these reasons, the Examiner has failed to establish a *prima facie* case of obviousness. Applicants respectfully request reconsideration and withdrawal of the rejection.

2. U.S. Patent No. 6,844,300 in view of Cook

The Examiner has rejected claims 1, 4-5, 7-8, 11-12, and 14-20 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,844,300 to Milner et al. ("Milner") in view of Cook. The Examiner has admitted that the difference between Milner and the presently claimed invention is the requirement in the claims of hydrocarbylamine b(i). See page 10 of the Office Action. However, the Examiner has argued that Cook overcomes the deficiency of Milner because it discloses the use of "ethylene oxide condensation products of N-tallow trimethylenediamine" (see page 13, para. [0139]) to form an amine salt of monothiophosphoric acid. See pages 10-11 of the Office Action. The Examiner has further argued that "Cook et al. also discloses the equivalence and interchangeability of using such alkoxylated amine ... with using alkyl amine as disclosed by Milner." See *id.* Applicants strongly disagree for at least the following reasons.

As the Examiner has acknowledged, Milner does not teach or suggest the claimed hydrocarbylamine b(i). For at least the reasons stated above in part B(1), Cook does not overcome the deficiency of Milner because Cook does not teach or suggest a

hydrocarbylamine compound selected from the group consisting of N-oleyl-trimethylene diamine, N-tallow-trimethylene diamine, N-coco-trimethylene diamine, and combinations thereof.

Although, the Examiner has argued that Cook teaches equivalence and interchangeability of its disclosed amines and Milner's disclosed amines, neither reference teaches or suggests the claimed hydrocarbylamine compound (b)(i). Moreover, because neither reference teach or suggests the claimed hydrocarbylamine compound neither reference teaches or suggests the claimed load carrying capacity enhancing combination (b).

For at least these reasons, the combination of Milner and Cook does not teach or suggest all of the claimed elements. Applicants respectfully request reconsideration and withdrawal of the rejection.

3. U.S. Patent No. 5,942,470 in view of Cook

The Examiner has rejected claims 1, 4-8, and 11-20 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,942,470 to Norman et al. ("Norman") in view of Cook. The Examiner has admitted that the difference between Norman and the presently claimed invention is the requirement in the claims of hydrocarbylamine b(i). See page 12 of the Office Action. However, the Examiner has argued that Cook overcomes the deficiency of Norman because it discloses the use of "ethylene oxide condensation products of N-tallow trimethylenediamine" (see page 13, para. [0139]) to form an amine salt of monothiophosphoric acid. See pages 10-11 of the Office Action.

As the Examiner has acknowledged, Norman does not teach or suggest the claimed hydrocarbylamine b(i). For at least the reasons stated above in part B(1), Cook

does not overcome the deficiency of Norman because, Cook does not teach or suggest a hydrocarbylamine compound selected from the group consisting of N-oleyl-trimethylene diamine, N-tallow-trimethylene diamine, N-coco-trimethylene diamine, and combinations thereof.

Although, the Examiner has argued that Cook teaches equivalence and interchangeability of its disclosed amines and Norman's disclosed amines, neither reference teaches or suggests the claimed hydrocarbylamine compound (b)(i). Moreover, because neither reference teach or suggests the claimed hydrocarbylamine compound neither reference teaches or suggests the claimed load carrying capacity enhancing combination (b).

For at least this reason, the references, alone or in combination, fail to teach or suggest the claimed invention. Applicants respectfully request reconsideration and withdrawal of the rejection.

4. U.S. Patent No. 5,700,764 in view of Cook

Applicants note that the Examiner has rejected claims 1, 4-5, 7-8, 11-12, 14 and 16-20 under 35 U.S.C. §102(b) over U.S. Patent No. 5,700,764 to Walters et al. ("Walters") in view of Cook. Applicants respectfully submit that this rejection is improper and should be withdrawn. Only a single reference should be used in making a rejection under 35 U.S.C. §102. MPEP 2131.01. A rejection under 35 U.S.C. §102 over multiple references has been held proper only when the extra references are cited to for three reasons that are inapplicable here. See *id.* For at least this reason, Applicants respectfully request reconsideration and withdrawal of the rejection.

5. U.S. Patent No. 5,126,064 in view of Cook

Applicants note that the Examiner has rejected claims 1, 4-8, and 11-19 under 35 U.S.C. §102(b) over U.S. Patent No. 5,126,064 to Barber et al. ("Barber") in view of Cook. Applicants respectfully submit that this rejection is improper and should be withdrawn. Only a single reference should be used in making a rejection under 35 U.S.C. §102. MPEP 2131.01. A rejection under 35 U.S.C. §102 over multiple references has been held proper only when the extra references are cited to for three reasons that are inapplicable here. See *id.* For at least this reason, Applicants respectfully request reconsideration and withdrawal of the rejection.

5. U.S. Patent No. 4,710,100

The Examiner has rejected claims 21-22 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,710,100 to Laing et al. ("Laing") in view of Cook. Applicants respectfully submit that claims 21 and 22 depend from independent claim 8 and are patentable for the same reasons as claim 8. Claim 8 has not been rejected over Laing in view of Cook.

The Examiner has argued that the difference between Laing and the present invention is the requirement in the present claims of specific composition. Cook does not overcome this deficiency of Laing because, as argued above, Cook fails to teach or suggest the presently claimed specific composition, i.e., the load carrying capacity enhancing combination (b).

For at least this reason, the combination of Laing and Cook does not teach or suggest all of the claimed elements. Applicants respectfully request reconsideration and withdrawal of the rejection.

CONCLUSION

In view of the foregoing remarks, applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 50-2961.

Respectfully submitted,

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